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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,135	09/27/2001	David Henry Hoeft	SE.01-01	1715
34431	7590	02/21/2006	EXAMINER	
HANLEY, FLIGHT & ZIMMERMAN, LLC 20 N. WACKER DRIVE SUITE 4220 CHICAGO, IL 60606			PROCTOR, JASON SCOTT	
			ART UNIT	PAPER NUMBER
			2123	

DATE MAILED: 02/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/964,135	HOEFT, DAVID HENRY	
	Examiner	Art Unit	
	Jason Proctor	2123	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 28 November 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 10-18 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 10-18 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/25/05</u> . | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claims 1-9 were rejected in Office Action of 26 May 2005. Applicants' response has cancelled claims 1-9 and presented new claims 10-18. Claims 10-18 have been rejected.

Requirement for Information – 37 CFR 1.105

The Examiner thanks Applicants' for fully responding to the previous Requirement for Information under 37 CFR 1.105.

Claim Rejections - 35 USC § 112

The previous rejections under 35 U.S.C. § 112, first and second paragraphs, have been withdrawn in response to the cancellation of claims 1-9.

Claim Objections

1. Claims 17-18 are objected to because of the following informalities: Claim 17 depends from itself. This claim is interpreted as depending from claim 17. Claim 18 is objected to by virtue of its dependence. Appropriate correction is required.

Claim Rejections - 35 USC § 102

Applicants' attention is respectfully drawn to the language of claim 10, which, when given a broad, reasonable interpretation, reads upon actual construction of a tangible swing-joint interconnection between tangible pipes. Although the plain meaning of the claim limitations

suggests this interpretation, the application is not believed to provide adequate support for this interpretation under 35 U.S.C. § 112. The Examiner respectfully suggests amending the preamble to exclude the interpretation that real-world swing-joint interconnections are to be created by the recited method.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 10-18 are rejected under 35 U.S.C. 102(b/a) as being anticipated by AutoSPRINK®.

The grounds for this rejection in the alternative under § 102(b) or § 102(a) is based on the publication date of AutoSPRINK®, an issue which has not been clearly resolved in the official record. Applicants' response submits the following:

As noted in the response to the Examiner's request for information under 35 CFR § 1.105, however, the release date for the swing-joint feature presently embodied in the AutoSPRINK® online documentation was at least after October 4, 2000.

However, this statement offers nothing to clarify the date when the online documentation was published. In the event that these dates coincide, this rejection is proper under 35 U.S.C. § 102(a). If the statement above should not be construed as the publication date of the online documentation, however, this rejection should be regarded under 35 U.S.C. § 102(b).

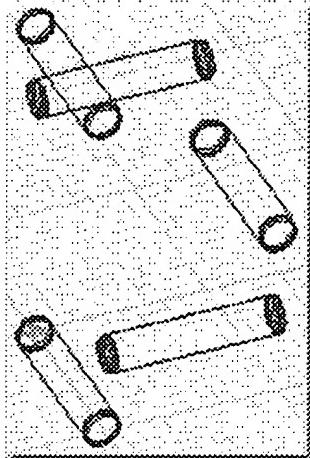
Regardless, the AutoSPRINK® online documentation applied as prior art in this rejection anticipates the claimed invention, a finding which has not been challenged by Applicants.

Regarding the date of AutoSPRINK®, the Examiner has provided the trademark status of “AUTOSPRINK”, owned by M.E.P.CAD, Inc., of Las Vegas, NV, which confirms the date of first use in commerce as November, 1997.

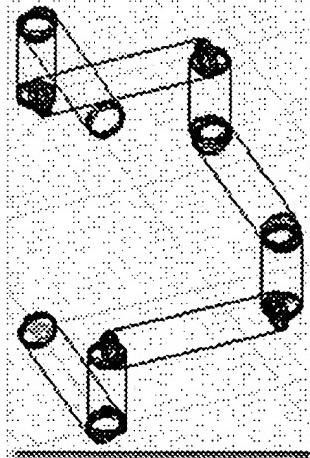
Regarding the claimed invention, the Examiner respectfully draws Applicants’ attention to the following excerpts from “AutoSPRINK online help”:

Regarding a “maximum jog-over distance” (AutoSPRINK online help, “Auto Draw Menu”, pages 6-7):

Swing Multiple

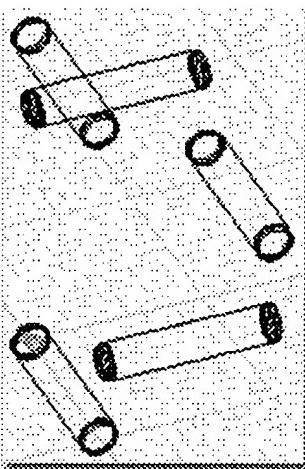


Auto Draw
Branch Lines...
Connect
Couplings...
Easy Draw...
Fittings...
Hangers...
Route Pipe...
Schedule Pipes...

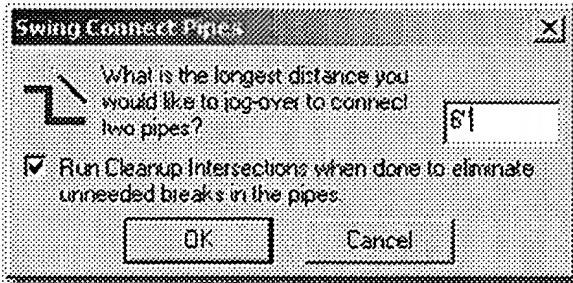


Swing Multiple connects all selected pipes at 90° angles wherever possible. One thing to note, however, is that Swing Multiple does not place fittings in the draw, only pipes. To add fittings, simply run Fittings from the AutoDraw menu once Swing Multiple has finished.

To run Swing Multiple, select the pipes to be connected and, from the AutoDraw menu, choose Connect and **Swing Multiple** from the Connect submenu.



Pipes to Target Pipe
Sprinklers to Pipes...
Swing Joint
Swing Multiple

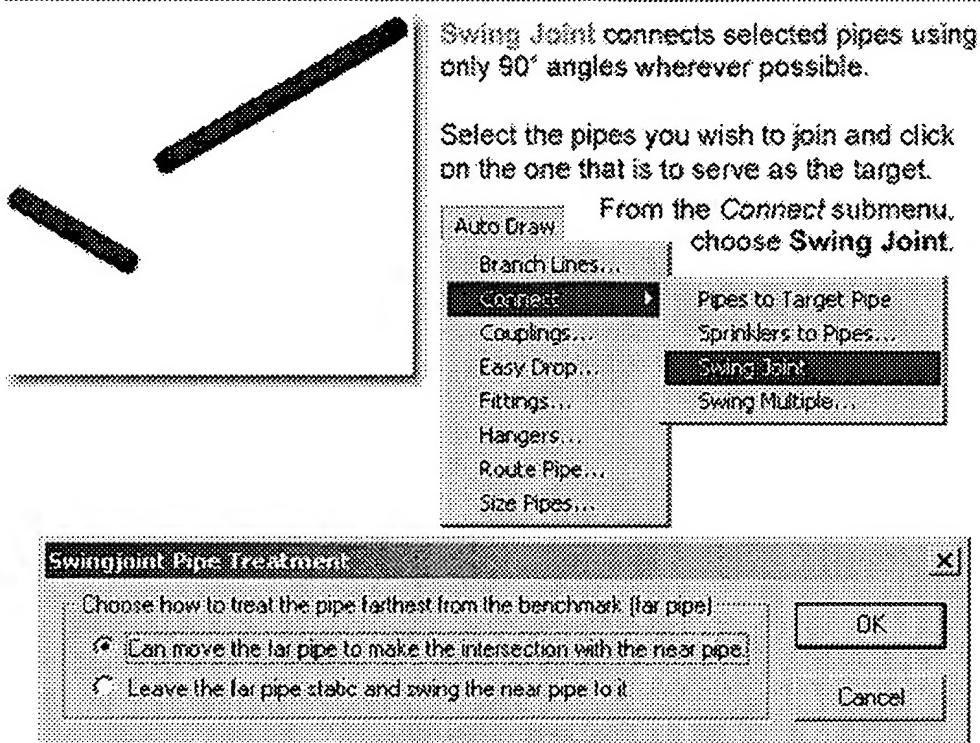


When the *Swing Connect Pipes* dialog opens, enter the maximum acceptable jog-over distance for the selected pipes. Checking the *Run Cleanup Intersections* box will eliminate any unnecessary breaks in the selected pipes. Click **OK** to activate. Remember, Swing Multiple only places pipe in the drawing; to add fittings, choose **Fittings** from the *AutoDraw* menu.

Print Help Exit

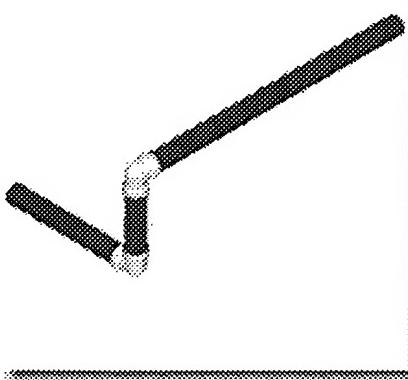
Regarding “generating a swing-joint layout object” (AutoSPRINK online help, “Auto Draw Menu”, page 6):

▲ Connect Swing Joint



If it is acceptable for the pipe farthest from the benchmark to be moved in order to establish the connection, choose the first option on the *Swing Joint Pipe Treatment* dialog. If the pipe farthest from the benchmark must not be moved, select the second option. Once you've designated the appropriate pipe treatment press the **OK** button.

Note: *Swing Joint* will both trim and create pipe to complete a joint composed of right angles.



Regarding "consolidating pipe segments" (AutoSPRINK online help, "Commands Menu", pages 12-13):

Delete Pipes and Close Gaps

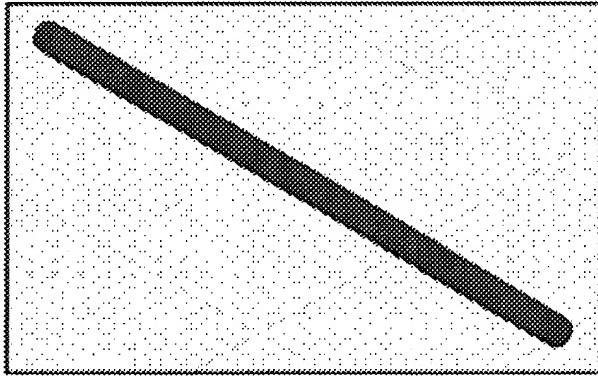
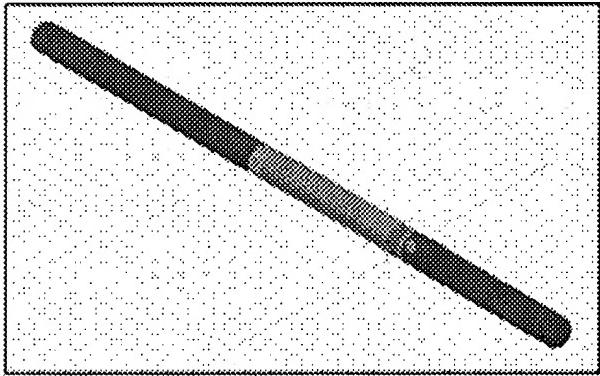
Access: Commands / Delete Pipes and Close Gaps

The Delete Pipes and Close Gaps command is used to eliminate unwanted pipe segments while maintaining a constant total length for the pipe of which the unwanted segments are a part. It removes the unwanted pipe and then stretches an abutting pipe segment to fill the resulting gap. Use this command as follows:

- o Select the pipe segment(s) to be deleted.
- o Select **Delete Pipes and Close Gaps** from the Commands menu. The selected segment(s) will be removed, and an adjacent segment will stretch to fill the gap.

If a pipe abuts both ends of the deleted pipe, the pipe forming the greater included angle with the highlighted pipe (i.e. the pipe that is more "in-line" with the highlighted pipe) will be stretched. If the included angles are equal, the longer pipe (i.e. the pipe resulting in less deflection) will be stretched.

The example below shows pipes before invoking this command (left) and after invoking it (right). Note how the longer adjoining segment is stretched to fill the gap.



Note: This command will not delete or stretch pipes under certain circumstances. For details, [click here](#).

AutoSPRINK anticipates every recited element of the claimed invention.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(f) he did not himself invent the subject matter sought to be patented.

3. Claims 10-18 are rejected under 35 U.S.C. § 102(f) because the applicant did not invent the claimed subject matter.

A search of the prior art has revealed documentation made of record by the Examiner that substantiates a rejection under 35 U.S.C. § 102(f). The facts, as understood by the Examiner, are as follows:

- David H. Hoeft, sole inventor of record in the instant application, is president of Software Engineering, Inc. (hereafter Software Engineering), as shown by the oath and declaration as well as the power of attorney on record with the office.
- Software Engineering produces and markets Symmetrica®, a computer drafting & modeling software package, as shown by Software Engineering's website, www.softwareengineering.com/clients.htm.
- Software Engineering publicly acknowledges M.E.P.CAD as not only clients of Software Engineering, but also acknowledges M.E.P.CAD as responsible for developing Software Engineering's Symmetrica® product into AutoSPRINK®, beginning in 1997, as shown by Software Engineering's website, www.softwareengineering.com/clients.htm.
- The trademark status for “AUTOSPRINK” confirms its first commercial use in 1997 and is owned by M.E.P.CAD.

The documented link between Software Engineering and M.E.P.CAD, bolstered by the anticipatory nature of the documentation for AutoSPRINK®, necessitates a complete rejection of the claimed invention under 35 U.S.C. § 102(f) until evidence made of record unambiguously defines inventorship of the claimed swing-joint creation feature. The evidence available to the office gives every indication that M.E.P.CAD is responsible for inventing the swing-joint creation feature.

In response, Applicants' submit "a redacted copy of a Statement of Work as Appendix A" and argue primarily that:

This Statement of Work should eliminate any rejection under 35 U.S.C. § 102(f) that may have been proper, as it is clear that the current inventor invented the claimed subject matter.

The Examiner respectfully traverses this argument as follows.

The Examiner has carefully considered Appendix A as well as the various materials submitted in response to the previous Requirement for Information while fully considering Applicants' arguments, however those arguments have been found unpersuasive.

Regarding Appendix A, the Examiner submits that this document is dated "April 1, 2004" and "is effective as of April 1, 2004" (Appendix A, page 1). This date is 43 months after October 2000, which date Applicants have admitted was "the release date for the swing-joint feature presently embodied in the AutoSPRINK® online documentation".

Secondly, regarding Appendix A, the Examiner submits that the Statement of Work makes no mention whatsoever of a "swing-joint" feature, which is clearly the inventive concept in the claimed invention (claims 10 and 16; title, abstract, specification).

Therefore Appendix A fails to show that the named inventor in this application had any relationship with M.E.P.CAD prior to the admitted date when the invention was published as a part of the AutoSPRINK® software. Additionally, Appendix A shows no evidence of the inventorship of the “swing-joint” feature, regardless of the date.

The Examiner has considered the additional materials submitted by Applicants, but finds no evidence to support Applicants’ position that the named inventor in this application was indeed the inventor of the “swing-joint” feature in AutoSPRINK®. Applicants are encouraged to refer to specific evidence in these materials to support their position.

A typical method to overcome a rejection under 35 U.S.C. § 102(f) is to show evidence that the references relied upon were derived from Applicants’ own work. In this case, no such evidence has been presented. Applicants’ arguments and evidence have been fully considered, but have been found unpersuasive.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

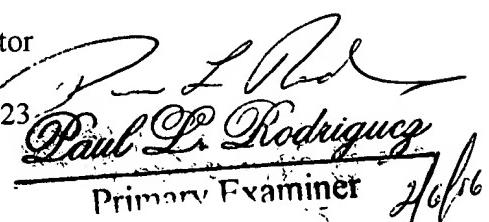
References cited on form PTO-892 but not applied as prior art have been cited to show the existence of the AutoSPRINK® product prior to the critical date for statutory bar in this application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Proctor whose telephone number is (571) 272-3713. The examiner can normally be reached on 8am-4pm M-FF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin J. Teska can be reached on (571) 272-3716. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-3713.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jason Proctor
Examiner
Art Unit 2123


Paul L. Rodriguez
Primary Examiner 2/6/16